

REMARKS

Claims 1, 3-5 are pending and under consideration in the application. Claims 2, 6, 7, 8, 10-14 were previously canceled. Claims 15 - 46 stand withdrawn.

In the present amendment, claims 1 and 3-5 were amended to better point out and distinctly claim the subject matter of the present application.

Rejections under 35 U.S.C. § 112

Claims 1, 3-5 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the limitation "said graphite material is further characterized by...the proportion of weight reduction as measured by DTG, is at least 5% and at most 40%" was not found to be not described in the specification. The above rejection was based on the finding that "The proportion of weight reduction disclosed by the specification does not refer to graphite, but refers to components other than graphite" (See the Office Action of August 29, 2006, page 3, first full paragraph).

Applicants submit that the claims were amended to include the limitation that said weight reduction is due to the component other than the graphite, as supported on page 11 of the present application. The rejection is now moot in view of the above.

Rejections under 35 U.S.C. §§ 102 and 103

Claims 1, 3-5 were rejected under 35 U.S.C. 102(b)/103(a) as being unpatentable in view of Hayashi et al. (Japanese Patent 10-334915). Applicants respectfully traverse and, for the following reasons, request reconsideration and withdrawal of this rejection.

To establish anticipation of the present invention, a reference must disclose the invention as set forth in the claim: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As also set forth in M.P.E.P. §2131, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that Hayashi et al. does not anticipate Applicants' invention as set forth in the claims as presently amended because Hayashi et al. fails to teach every element and limitation of the claims at issue. In particular, Hayashi et al. fails to disclose "the proportion of weight reduction as measured by DTG is at least 5% and at most 40%". Accordingly, because Hayashi et al. fails to teach each and every element and limitation of Applicants' claims 1 and 3-5, Hayashi et al. does not anticipate the invention as claimed.

The Office Action also states that the claims are alternatively unpatentable, as follows:

Hayashi does not explicitly state the proportion of weight reduction as measured by DTG, is at least 5% and at most 40%. However, the limitation is a product-by-process limitation, which is not given patentable weight in the absence of unexpected results.

(See the Office Action of August 29, 2006, page 5, last paragraph).

Applicants submit that, contrary to the above, the proportion of weight reduction does indeed yield unexpected results. Specifically, a graphite material defined by the DTG curve of the present invention has a structure in which a component having a different structure from the inside of the particles sufficiently covers the surface of the particles to form the reformed portion. Also, the irreversible capacity of a battery using the graphite material for the negative electrode can be remarkably reduced (See, for example, the Specification of the present application, page 12, first two paragraphs).

The cited reference is completely silent as regards the above structural features, let alone their effect on the capacity of the battery. Accordingly, Hayashi et al. would have not provided one of ordinary skill in the art with any disclosure or suggestion regarding the subject matter of the claims, and the rejection should be removed.

Conclusion

Applicants submit that claims 1 and 3-5 are patentable and that the present application is now in condition for allowance. Notice to that effect is respectfully requested.

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Respectfully submitted,



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